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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,814	03/18/2004	Masakatsu Kiwada	09473.0003	5875
22852	7590	03/31/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER PARK, CHAN S	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 03/31/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/802,814

Applicant(s)

KIWADA, MASAKATSU

Examiner

CHAN S. PARK

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☒ Claim(s) 1-6 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date 10/18/04 & 3/23/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species I in the reply filed on 2/27/08 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

2. An initialed and dated copy of Applicant's IDS form 1449 filed on 10/18/04, is attached to the instant Office action.

Claim Objections

The following quotations of 37 § CFR 1.75(a) is the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

3. Claims are objected to because of the following informalities:

Claim 1, line 14, "attribute information" should be -- the attribute information --;

Claim 1, line 30, "the image data" should be -- the modified image data --;

Claim 2, line 8, "the image data" should be -- the modified image data --;

Claim 3, line 5, "the image data" should be -- the modified image data --;

Claim 3, line 7, "the image data" should be -- the modified image data --;

Claim 4, line 14, "attribute information" should be -- the attribute information --;

Claim 4, lines 29-30, "the image data" should be -- the modified image data --;

Claim 5, line 8, "the image data" should be -- the modified image data --;

Claim 6, line 5, "the image data" should be -- the modified image data --;

Claim 6, line 7, "the image data" should be -- the modified image data --;

Claim 7, line 15, "attribute information" should be -- the attribute information --;

Claim 7, lines 30-31, "the image data" should be -- the modified image data --;

Claim 8, line 8, "the image data" should be -- the modified image data --;

Claim 9, line 5, "the image data" should be -- the modified image data --; and

Claim 9, line 7, "the image data" should be -- the modified image data --.

4. Claim 1 recites the limitation "the electronically tagged printing paper" in line 29. It is unclear if this printing paper is referring to the electronically tagged printing paper recited in lines 23-24 or the electronically tagged printing paper recited in lines 4-5. The examiner notes that, in light of the Specification wherein on pages 25-26, this claimed limitation refers to the electronically tagged printing paper recited in lines 23-24. If the applicant agrees with the examiner's interpretation of the claim, the examiner suggests the following changes for a clarification:

Lines 23-24, "on an electronically tagged printing paper" should be -- on another electronically tagged printing paper --;

Line 25, "the printing paper" should be -- the another printing paper --;

Line 29, "on the electronically tagged printing paper" should be -- on the another electronically tagged printing paper --;

Claim 2, lines 6-7, "on the electronically tagged printing paper" should be -- on the another electronically tagged printing paper --;

Claim 3, line 5, "said printing paper" should be -- said another printing paper --;
and

Claim 3, line 6, "on the electronically tagged printing paper" should be -- on the another electronically tagged printing paper --.

The examiner suggests either using "another electronically tagged printing paper" or "second electronically tagged printing paper" to clearly distinguish from the original electronically tagged printing paper.

With respect to claims 4, 7 and 10, arguments analogous to those presented for claim 1, are applicable.

With respect to claims 5 and 8, arguments analogous to those presented for claim 2, are applicable.

With respect to claims 6 and 9, arguments analogous to those presented for claim 3, are applicable.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 7-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 19-28 are drawn to functional

descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Also, refer to page 53 of the Interim Guideline.

Claims 7-9, while defining a computer program product, do not define a "computer-readable medium" and are thus non-statutory for that reason. A computer program product can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claims to state, "A computer-readable medium encoded with an image forming computer program..." in order to make the claims statutory.

If the applicant wishes to make the correction as suggested by the examiner, claim 10 should be canceled upon amending the claims. Also, by combining claims 7 and 10 together in one independent claim, it will make the claim statutory.

ALLOWANCE

Allowable Subject Matter

6. Claims 1-6 and 10 would be allowable if rewritten or amended to overcome the objections under 37 § CFR 1.75(a), set forth in this Office action.

Independent claims 1, 4 and 10 define an image forming device/method for printing image data stored in electronic tag, wherein said electronic tag is equipped

within an electronically tagged printing paper and said tag further stores attribute information as depicted in figures 3 and 4. The claimed device/method comprises a displaying unit/step for displaying modifiable items among the attribute information and an attributes information modifying unit/step for modifying the attribute information displayed by said display unit/step. The claims distinguish over the prior art in that a writing unit/step writes the attribute information and the image data on the electronic tag of the another/new electronically tagged printing paper on which the modified image data modified according to the modified attribute information is printed. The claimed combination provides a device/method for storing the original image data and its attribute information on the electronic tag of the new printing paper even if the image data printed on the new printing paper is modified.

The most relevant prior art Teraura (U.S. Patent No. 6,827,279) teaches a method of scanning a printing paper having an RFID tag for storing the copy-prohibiting field (fig. 11). Teraura further teaches the method of reading an image on the paper together with the information in the RFID tag (col. 7, lines 60-66). However, Teraura does not teach the writing unit/step for writing the attribute information and the image data on the electronic tag of the another/new electronically tagged printing paper on which the modified image data modified according to the modified attribute information is printed.

Many prior art references teaches the concept of reading the image data from an electronic tag mounted on a printing paper. For example, Ostrover et al. (U.S. Patent No. 6,585,154) and Tanaka et al. (Japanese Patent Publication No. 2000/0285203)

teach the concept of storing image data in an electronic tag mounted on a printing paper and reading the image data from the tag for printing. However, both references do not teach the claimed combination of displaying, modifying and writing units/steps.

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Examiner, Art Unit 2625
March 27, 2008